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1-7-03 1731

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. : 40544.00301  
Applicants : Gilchrist, et al.  
Serial Number : 09/424,811  
Title : Method of Producing Water-Soluble Glass Fibers  
Filed : 30 November 1999  
Art Unit : 1731

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Commissioner of Patents  
Washington, DC 20231

**Attention: Office of Petitions**

**REQUEST FOR RECONSIDERATION OF A PORTION OF  
A DECISION ON PETITION MAILED 12 OCTOBER 2002**

This is a request for reconsideration of a portion of the decision on a petition, which decision was mailed 21 October 2002 from the United States Patent and Trademark Office according to a paper numbered 25 bearing a mailing date of 26 November 2002.

In this request for reconsideration of a portion of the decision on the petition, applicants specifically request reconsideration of the first portion of the decision on the petition under the heading "I".

That portion of the decision dealt with two information disclosure statements, dated 23 June 2000 and 2 July 2001 respectively, and applicant's position that the examiner should have considered those information disclosure statements and the materials submitted therewith on their merits.

Applicants note with appreciation the portion of the decision in the petition stating that upon the mailing of the decision on the petition that the application file was to be returned to the examiner for prompt preparation of a written confirmation that the Derwent published English language abstracts of JP58-004821A or JP48-042814B had been fully considered by the examiner. In that regard, applicants respectfully request that instruction be given to the examiner to fully consider the Derwent published English language abstracts of **both** JP58-004821A **and** JP48-042814B and that the examiner **not be given the option of considering one but not the other** of the “English Language Abstracts of JP58-004821A or JP48-042814B” as cited in the decision on the petition. The Commissioner’s attention is specifically directed to the alternative “or” language appearing in the decision on petition. The relevant language from the decision, which is quoted verbatim above, is repeated again for emphasis: “English Language Abstracts of JP58-004821A or JP48-042814B”

In the decision, it is noted that the international search report for PCT/GB98/01597 did not cite JP58-004821A or JP48-042814B but rather cited Derwent published English Language Abstracts of these two Japanese patents.

As further stated in the decision on petition, quoting from the Manual of Patent Examining Procedure Section 609, the examiner should consider the documents cited in the international search report in a PCT National Stage application when a form PCT/DO/EO/903 indicates that both the international search report and the copies of the document (listed thereon) are present in the national stage file.

In the decision on petition, it stated (in boldface type) that **“in such a case, the examiner should consider the documents for international search report and**

indicate by a statement in the first office action that the information has been considered.”

In the decision on petition, the Commissioner states that since the PCT/DO/EO/903 indicated that both the international search report and the copies of all the references cited in the international search report were present in a national stage file, the examiner erred by not notifying applicants in the first office action that the Derwent published English Language Abstracts of JP58-0044821A or JP48-042814B were considered by the examiner.

Applicants respectfully submit that in light of the language in the MPEP cited in the decision, it is clear that **both** of the English language abstracts of the two Japanese patents should have then and should be now considered by the examiner. The examiner should not be given the option of considering only one of those two English language abstracts. Accordingly, applicants request reconsideration of this portion of the decision on the petition and correction of the same to indicate the examiner shall be required to consider **both** of the English language abstracts of the two Japanese patent publications when the application file is remanded to the examiner.

Applicants further request reconsideration of the statement in the decision that “the information disclosure statements of June 23, 2000 and July 3, 2001 did not comply with 37 CFR 1.98(a)(2)(i) since no copies of JP58-0044821A or JP48-042814B were submitted by the applicant.” No such copies were available to the applicants, as noted above.

In the decision it is stated that the examiner properly followed the procedure set forth in MPEP 609 by lining through the citation since those citations purportedly did not comply with all of the requirements of 37 CFR 1.97 and 37 CFR 1.98.

Applicants disagree and request reconsideration. The error in the decision on petition and the basis for reconsideration of this point is that the English language abstracts of the Japanese patent publications, while not qualifying as a patent, certainly qualified as "other information" and were appropriately submitted in that frame under 37 CFR 1.98.

37 CFR 1.98(a) states that an information disclosure statement filed under 1.97 shall include (1) a list of all . . . **other information** submitted for consideration by the office, (2) a legible copy of . . . (iv)... all **other information** or that portion which cause it to be listed and (3) (i) **an explanation of the relevance of such other information that is not in the English language.**

Applicants respectfully submits that the information disclosure statements of 23 June 2000 and 2 July 2001 fully comported with the requirements of 37 CFR 1.98(a)(1),(2) and (3) in that the **two English language translations** of the Japanese patent abstracts **were listed** on the information disclosure statement thereby comports with the requirement of 37 CFR 1.98(a)(1). The **legible copies of each of the two English language translations** of the two Japanese patent abstracts **were supplied** in accordance with the requirements of 37 CFR 1.98(a)(2). Under 37 CFR 1.98(a)(3)(i) **no concise explanation of the relevance of that information was required** since that information was in the English language.

Accordingly, applicants respectfully submit that the requirements of 37 CFR 1.98(a) were fully met by the information disclosure statements of 23 June 2000 and 2 July 2001 and that it was error on the part of the Commissioner, in deciding the petition, to fail to realize that the English language abstracts of the Japanese patent publications in question qualified as "other information" under the provisions of 37 CFR 1.98(a).


Accordingly, reconsideration and correction of this portion of the decision is respectfully solicited.

Applicants believe it is important to correct the record in this regard, especially in light of the clear error in the language in the decision indicating that when the application file is returned to the examiner for mailing of written confirmation that one, **but not necessarily both**, of the Derwent published English language abstracts of JP58-004821A "or" JP48-042814B has been fully considered.

We respectfully solicit all of the foregoing.

To the extent any fee may be required in connection herewith, please charge the same to applicants' undersigned counsel's deposit account 50-1943.

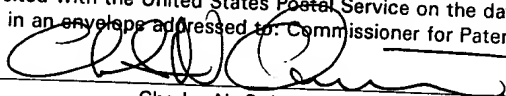
Respectfully submitted,

Date: 23 December 2002 

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CERTIFICATE OF MAILING  
UNDER 37 C.F.R. 1.8(a)

I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Commissioner for Patents, Washington, DC 20231



Charles N. Quinn

23 December 2002